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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,762	07/22/2005	Karin Schutze	060526.000008	9270
70416 7590 09/03/2008 THELEN REID BROWN RAYSMAN & STEINER LLP P.O. BOX 640640 SAN JOSE, CA 95164-0640				
EXAMINER				
FRITCHMAN, REBECCA M				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/535,762

**Applicant(s)**

SCHUTZE ET AL.

**Examiner**

REBECCA FRITCHMAN

**Art Unit**

4112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CS-100)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 05/20/2005

***Detailed Action  
Summary***

1. This is the initial Office action based on the 10/535762 application filed on 07/22/2005.
2. Claims 1-18 are pending and have been fully considered.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-8, 10, 12, 15-16, & 18 are rejected under 35 U.S.C. 103(a) as being obvious over GANSER in US 6787301 in view of JAMES in US 2914746.

GANSER et al. teach of a method for laser microdissection which allows a specimen field to be cut out from a specimen in a reliable and convenient fashion. Specifically, with respect to Claim 1, GANSER et al. teach of a laser microdissection device with a microscope for observing biological material on a specimen holder (column 2, lines 31-49), (column 1, lines 15-20). GANSER et al. also teach of a holder which is provided for receiving the biological object which is excised from the biological material (column 2, lines 57-67 & column 3, line 1-11). GANSER et al. does not teach of identifying receptacles by evaluating coding. JAMES et al. does teach of detecting and identifying an object by evaluating coding through sensing a cut away section magnetically, inductively, capacitatively, photoelectrically, or by other means (column 13, lines 47-58).

JAMES et al. teach of a disc being attached to the scanning shaft, the position of any particular part of the impressed codes can be detected. (Column 13, lines 47-72). It would have been obvious to combine the method of laser microdissection of GANSER and the method of detecting and evaluating coding of JAMES due to the fact that the current methods of laser microdissection is cumbersome and time consuming (GANSER, column 1, lines 59-61). It is thought that identifying and evaluating objects by coding would make the process less cumbersome.

With respect to Claim 2, GANSER et al. teach of a laser which generates a laser beam having at least one optical system that couples the laser beam into the objective(column 2, lines 36-49)(optical scanning), and of a specimen holder(column 2, lines 57-67) . JAMES et al. teach of detecting impressed codes by cutting away a portion of the complete disc at a particular length around the periphery and then sensing this cut-away section photoelectrically, magnetically, inductively, capacitatively, or by other means, in which a signal may be generated at variously located points to initiate or disable the action desired(column 13, lines 47-57). From this, it would be obvious to optically scan the coding wherever it might be.

With respect to Claim 3, JAMES et al. teach of detecting impressed codes by cutting away a portion of the complete disc at a particular length around the periphery and then sensing this cut-away section photoelectrically, magnetically, inductively, capacitatively, or by other means, in which a signal may be generated at variously located points to initiate or disable the action desired (column 13, lines 47-57).

With respect to Claim 4, JAMES et al. teach of detecting impressed codes by cutting away a portion of the complete disc at a particular length around the periphery and then sensing this cut-away section photoelectrically, magnetically, inductively, capacitatively, or by other means, in which a signal may be generated at variously located points to initiate or disable the action desired (column 13, lines 47-57).

With respect to Claim 5, GANSER et al. teach of monitoring the camera image (column 6, lines 58-65). JAMES et al. teach of recording a code which can either be erased or used for other purposes and also of a signal which may be generated at variously located points to initiate or disable the action desired(column 13, lines 47- 58). This would make it obvious to record an

image on a reproduction device because the reproduction device solely duplicates the original image.

With respect to Claim 6, GANSER et al. teach of the specimen holder resting on an X-Y stage which allows different specimen regions to be viewed and selected( column 3, lines 1-11).

With respect to Claim 7, GANSER et al also teach of a holder which is provided for receiving the biological object which is excised from the biological material (column 2, lines 57-67 & column 3, line 1-11). GANSER et al. also teach of the apparatus for laser cutting that operates with a stationary laser beam and a specimen moved relative there (column 2, lines 28-38), and of adjusting the microscope system by use of an X-Y stage (adjustment device).

With respect to Claim 8, GANSER et al. teach of monitoring the camera image (column 6, lines 58-65). JAMES et al. teach of recording a code which can either be erased or used for other purposes and also of a signal which may be generated at variously located points to initiate or disable the action desired(column 13, lines 47- 58). This would make it obvious to record an image designed in such a way in which you can manipulate the recording means (since the generation of the signal can initiate or disable the action desired).

With respect to Claim 10, GANSER et al. teach of a laser microdissection device with a microscope for observing biological material on a specimen holder (column 2, lines 31-49), (column 1, lines 15-20). GANSER et al also teach of a holder (receptacle device) which is provided for receiving the biological object which is excised from the biological material (column 2, lines 57-67 & column 3, line 1-11) specifically being an X-Y stage (holder) which has a glass specimen slide (plate) (column 2, lines 57-67, & column 3, lines 1-11) which allows

for control of the dissection protocol for a dissection work sequence which can be carried out with respect to the receptacle device.

With respect to Claim 12, GANSER et al. teach of a laser which generates a laser beam having at least one optical system that couples the laser beam into the objective(column 2, lines 36-49) (optical scanning), and of a specimen holder(column 2, lines 57-67) . JAMES et al. teach of detecting impressed codes by cutting away a portion of the complete disc at a particular length around the periphery and then sensing this cut-away section photoelectrically, magnetically, inductively, capacitatively, or by other means, in which a signal may be generated at variously located points to initiate or disable the action desired(column 13, lines 47-57). From this, it would be obvious to optically scan the coding wherever it might be.

With respect to Claim 15, teach of detecting impressed codes by cutting away a portion of the complete disc at a particular length around the periphery and then sensing this cut-away section photoelectrically, magnetically, inductively, capacitatively, or by other means, in which a signal may be generated at variously located points to initiate or disable the action desired (column 13, lines 47-57).

With respect to Claim 16, teach of detecting impressed codes by cutting away a portion of the complete disc at a particular length around the periphery and then sensing this cut-away section photoelectrically, magnetically, inductively, capacitatively, or by other means, in which a signal may be generated at variously located points to initiate or disable the action desired (column 13, lines 47-57).

With respect to Claim 18, GASER et al. teach of a specimen holder (receptacle device) which is one an X-Y stage (holder) which is a glass specimen slide (plate) (column 2, lines 57-67, & column 3, lines 1-11).

7. Claims 9, 11, 13, 14, & 17 are rejected under 35 U.S.C. 103(a) as being obvious over GANSER in US 6787301 in view of JAMES in US 2914746 as applied to claims 1-8, 10, 12, 15-16, & 18, and in further view of TITUS in US 6152662.

The limitations of Claims 1-5, 6, 8, 12, 15-16, & 18 are taught in the above 103(a) rejection.

GANSER et al. teach of a method for laser microdissection which allows a specimen field to be cut out form a specimen in a reliable and convenient fashion. JAMES et al. teaches of detecting and identifying an object by evaluating coding (column 13, lines 47-58). GANSER and JAMES do no teach of the use of a transponder, or a frame. TITUS et al. does teach of a transponder (column 15, lines 65-67 & column 16, lines 1-9), and the use of a frame (column 5, lines 9-10).

With respect to Claim 9, TITUS et al. teach of recording an image (column 15, lines 44-53). JAMES et al. teach of recording a code which can either be erased or used for other purposes and also of a signal which may be generated at variously located points to initiate or disable the action desired(column 13, lines 47- 58). It would be obvious to do this in the region in which the biological objects are dissected because laser microdissection refers to cutting out a small piece from a specimen which is thus available for further biological or medical examinations(imaging)(column 1, lines 15-20).



With respect to Claim 11, TITUS et al. teach of the rotatable platform being mounted to an apparatus frame by rotatable bushing (column 5, lines 9-10).

With respect to Claim 13, TITUS et al teach of the key coding comprising a series of comb-like projections to shape the key, so that the key can be identified and different or the same from other keys (Figure 7). This would make it obvious to code the receptacle device in the same fashion.

With respect to Claim 14, TITUS et al. describe the use of a bar code which may be read by a bar code reader (column 15, lines 54-64).

With respect to Claim 17, TITUS et al. teach of the use of a transponder for use in security (column 15, lines 65-67 & column 16, lines 1-9). From this it would have been obvious to use a transponder as part of a code (which is often used for security/identification purposes).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to REBECCA FRITCHMAN whose telephone number is (571)270-5542. The examiner can normally be reached on Monday- Friday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilliam Barbara can be reached on 571-272-1330. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

R.F.

/Barbara L. Gilliam/  
Supervisory Patent Examiner, Art Unit 4128